

## **REMARKS**

### **STATUS OF THE CLAIMS**

Claims 1, 3-6, 8-11, 13-16, 18-21, and 23-26 are pending in the application.

Claims 1, 11, 21 are independent claims.

Claims 1, 6, 8-10, 21 and 23 are rejected under 35 USC 102(a).

Claims 3-5, 11, 13-16, 18-20 and 24-26 are rejected under 35 USC 103 (a).

## **RESPONSE**

The Applicants appreciate the Examiner's examination of the subject Application and request that reexamination of the claims and reconsideration of the Application be made in view of the preceding amendments and the following remarks:

### **THE §102 REJECTION**

Claims 1, 6, 8-10, 21 and 23 were rejected under 35 U.S.C. §102(a) as being anticipated by UK Patent (GB-2159461 A). This rejection is respectfully traversed as follows.

It has been established that there is no anticipation unless (1) all the same elements are (2) found as contained in the claim and (3) are arranged the same way to (4) perform the same function. As amended, independent Claims 1 and 21 and the '461 UK patent do not have the same elements. Below are detailed the novel elements of this invention and why those elements are absent in the '461 UK patent.

### Utilizing Contrast To “Hide” The Micro Scale Features

As amended, Claims 1, 11, and 21 recite a “minimal contrast hiding said second printed matter from the naked eye; said minimal contrast effected by said second color constituting means for hiding said second printed matter from the naked eye; said second micro scale constituting means for rendering said second printed matter not ascertainable by the naked eye;

wherein said second printed matter is hidden, and cannot be perceived without magnification of the second micro printed matter”. Applicants believe this characteristic was present in the Claims as amended in the response filed June 22, 2001 by virtue of the language in Claims 1, 11, 21 (as filed June 22, 2001 ) “said second color being selected to effect minimal contrast between said second printed matter in said second location and its immediate background so as to hide said second printed matter from the naked eye;

wherein said second printed matter is hidden”. The concept is well described in the original application in p.9, lines 22-24, namely, “Minimizing the contrast between the small scale text and background reduces the possibility that persons viewing the card will notice the small scale text and thereby “hides” the text in the background color”. This provides an additional anti-counterfeiting feature besides the use of micro-scale. As stated in the original application, the micro-scale is a “smaller scale” that “would require magnification for the text to be resolved by the viewing person with sufficient clarity to be read” (p. 5, lines 25-26). Thus, two different means of preventing counterfeiting – (a) using a micro-

scale to make the information not readable (i.e., not ascertainable) with the naked eye and (b) using contrast to make the micro-scale information harder to find in the document. If only the microscale were to be used, a counterfeiter could find the location of the microscale information, which will look like a thin line or a dot to the naked eye, and using sufficient magnification, would be able to read (ascertain) the information and copy it or make a document with the modified microscale information.

The '461 UK patent only teaches the use of microscale. In p. 2, col. 1, lines 4-5 of the '461 UK patent teaches that the microscale can be read by "the insertion of the card, or that part of the card bearing the microfilm or micro print information into a suitably adapted reader or projector" where "such information can be shown in a greatly enlarged form on the screen of the reader". The '461 UK patent does not explicitly or implicitly teach the use of contrast.

The Examiner asserts that the '461 UK patent teaches the use of "the second color being of any desirable color selected to effect minimal contrast at any degree" and references col.2, lines 127 to 130 of the '461 UK patent. Page 1, col. 2, lines 127 to 130 of the '461 UK patent teach "whereas the microfilm or micro print information cannot be ascertain or readily ascertain by the naked eye (even in with the aid of a magnifying lens)". To "ascertain" according the Oxford English Dictionary is "to make sure of, get to know". "Readily", according to the Oxford English dictionary is "with ease or facility". To get to know or to get to know with ease or facility the information contained in the micro-scale does not allow one to find a hidden object. To find a hidden object one must discern or detect its location. Furthermore, it would not be possible to

detect contrast by means of any magnification.

Contrast, in the image analysis and processing art, is a term of art. For example, see W. F. Schreiber, *Fundamentals of Electronic Imaging Systems*, Springer Verlag, Berlin, Germany, 1991, pp. 60-65 (see Attachment). “More important for ordinary view is the detection of a difference in luminance between a small area and a uniformly illuminated background.” The contrast is defined as the ratio of the difference in luminance,  $\Delta L$ , to the luminance of the background,  $L_0$ . From experimental data, there exists a minimum detectable contrast in the range of normal seeing, called the Weber–Fechner fraction. Thus, it is possible to “hide” information by means of contrast. Note that, when contrast is used to hide information, the detectability of the information is altered. **The ‘461 UK patent does not teach the use of contrast.**

The Applicants’ invention, as claimed, comprises “said second color constituting means for hiding said second printed matter from the naked eye” and “said second micro scale constituting means for rendering said second printed matter not ascertainable by the naked eye” while the ‘461 UK patent only teaches the use of microprint or microfilm for reducing the ascertainability.

### **THE §103 REJECTION**

In regards to Claims 3-5, 11, 13-16, 18-20 and 24-26, since the ‘461 UK patent does not disclose all the elements of Claims 1 and 21 (as detailed above), the rejection is respectfully traversed. As stated above, the ‘461 UK patent does not disclose all the elements of the applicants’ invention and therefore, it would not be obvious to take the teachings of the ‘461 UK patent and obtained of the inventions of Claims 3-5,


11, 13-16, 18-20 and 24-26. There is no motivation to introduce the use of contrast to hide information into the teachings of the '461 UK patent and obtain the applicants' invention. There is no suggestion in the '461 UK patent of how to make the modifications to obtain the applicants' and invention.

In regards to Claim 11, the combination of "documents" with information "specific to the particular person identified in each card" and with micro-scale information hidden by use of contrast result in an effect ("tamper resistant identification documents") "greater than the sum of the separate effects" (documents) "taken separately". *Anderson-Black Rock Inc. v. Pavement Salvage Inc.*, 163 USPQ 673.

Regarding Claims 3-5, 13-16, 24-26, the characteristics of the "instant product" (identification documents with micro-scale information hidden by use of contrast) are "important because" they "result in a different product which is distinct from reference product" (identification documents or identification documents with micro-scale not using contrast). *Ex parte Hilton*, 148 USPQ 356.

Accordingly, entry, re-examination and reconsideration are respectfully requested in view of the above amendment and remarks.

Respectfully submitted



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